

REMARKS

Applicant has canceled withdrawn claims 1-15, 17-39, 42, and 44-118 without prejudice or disclaimer. Claims 40, 41, and 43 are pending.

In the final Office Action, the previous claim rejections under 35 U.S.C. §§ 102(b) and 103(a) were withdrawn. Applicant greatly appreciates the Examiner's withdrawal of those claim rejections.

Claims 40, 41, and 43 were rejected in two separate, provisional obviousness-type double patenting rejections. The first is based on claim 1 of U.S. Application No. 10/744,394 ("394 application"). The second is based on claim 1 of U.S. "Application No. 10/744,390," which is entitled: COLUMNAR STRUCTURED MATERIAL AND MANUFACTURING METHOD THEREFOR. Since claim 1 of U.S. Application No. 10/744,390 appears to be directed to completely unrelated subject matter, the Office Action at p. 3 appears to contain a typographical mistake. Based on the Examiner's statement in the Office Action at p. 4 that the new grounds of rejection are based on information cited in the Information Disclosure Statement ("IDS") filed on December 29, 2004, the Examiner may have intended to list claim 1 of U.S. Application No. 10/744,340 ("340 application") rather than claim 1 of U.S. Application No. 10/744,390.¹

¹ If this Amendment After Final does not place the application in condition for allowance, Applicant respectfully requests that the Examiner reconsider and withdraw the final status of the Office Action because the '394 and '340 applications were not cited for the first time in the IDS filed on December 29, 2004. Indeed, both the '394 application and the '340 application were previously cited in the IDS filed on March 22, 2004. Thus, the IDS filed on December 29, 2004 could not have "prompted" the new grounds of rejection, as asserted in the Office Action at p. 4.

Accordingly, the following remarks are based on an assumption that the second obviousness-type double patenting rejection relies on claim 1 of the '340 application.²

Applicant respectfully disagrees with the provisional obviousness-type rejections and submits that they should be withdrawn for at least the following reasons.

As set forth in M.P.E.P. § 804 II.B.1,

[a]ny obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application;³ and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.⁴

The Office Action lacks such an analysis for all of the differences between the claims and, therefore, clearly fails to set forth a *prima facie* case of unpatentability. For example, neither one of the provisional claim rejections addresses certain recitations in independent claim 40 of the present application, such as the “means for precluding relative sliding movement,” or certain recitations in independent claim 43 of the present application, such as “first and second magnets [that] are rectangular.” Such features are not recited in claim 1 of the '394 application or claim of the '340 application, and they would not have been obvious to one of ordinary skill in the art.

² If the Examiner maintains the second provisional obviousness-type double patenting rejection, Applicant respectfully requests that the Examiner clarify whether the rejection is based on claim 1 of the '340 application.

³ Given that this is a provisional obviousness-type double patenting rejection, the “claim in the patent” is provisionally considered to be claim 1 of the '394 application or '340 application (depending on the rejection at issue), and the “claim in the application” is the claim at issue in the present application.

⁴ See footnote 3.

Furthermore, the Office Action does not establish a *prima facie* case of obviousness because the Office Action does not cite any legally sufficient suggestion or motivation to modify the claims of the '340 and '394 applications as proposed in the Office Action. Specifically, nothing supports the Office Action's assertions that "[i]t would have been obvious . . . to set forth the orientation of the magnets in an open orientation to indicate the opening motion between the hinge parts." Office Action at 3 and 4. Such unsupported, conclusory assertions clearly reflect impermissible hindsight gleaned from the present application. Neither claim 1 of the '340 application nor claim 1 of the '394 application teaches or suggests each and every feature of instant claims 40 and 43 and thus *prima facie* obviousness has not been established.

Moreover, the provisional, obviousness-type double patenting rejections should also be withdrawn because the Office Action improperly applies a one-way determination of obviousness (only evaluating whether the instant application claims are obvious over claims of the '340 and '394 applications), rather than a two-way determination of obviousness (evaluating both whether the instant application claims are obvious over claims of the '340 and '394 applications, and whether the claims of the '340 and '394 applications are obvious over the instant application claims).

As explained in M.P.E.P. § 804 II.B.1 (a) and (b), the two-way test for obviousness is applicable when administrative delay on the part of the U.S. Patent and Trademark Office (USPTO) causes delay in the prosecution of the earlier application, and when all of the claims could not have been filed in a single application. Such factors are applicable to the present application. If the later filed '340 application and/or the '394 application issue before the present application, it will be due to administrative

delay of the USPTO. Indeed, the current owner of the present application did not file or prosecute either the '340 application or the '394 application, and the current owner of the present application did not even have access to the contents of either of those applications before they published, so there clearly has not been any delay in the prosecution of the present application to permit prior issuance of any patents from the '340 and '394 applications.

Focusing on the second factor needed to have a two-way test apply (whether all of the allegedly conflicting claims could have been filed in a single application), the present application does not explicitly refer to plates pivoting about a hinge axis in respective parallel planes transverse to a hinge axis and maintaining magnets in the same magnetic orientation in open and closed positions, as required in all of the claims of the '340 and '394 applications, so the claims of those applications could not have been filed in the present application. Consequently, the two-way test for obviousness should be applied.

For at least these reasons, Applicant respectfully requests that the provisional obviousness-type double patenting rejections be withdrawn. Since those rejections are the only grounds of rejection applied to claims 40, 41, and 43, those claims should be allowable.

Applicant respectfully requests the entry of this Amendment After Final, the Examiner's reconsideration of the application, and the timely issuance of a Notice of Allowability.

Applicant notes that the Office Action contains a number of assertions concerning the claims of the present application. Applicant declines to subscribe to any

assertion in the Office Action regardless of whether it might be addressed specifically herein.


If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 6, 2005

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